

REMARKS

Claims 28, 31-36 and 38-49 are pending. Claims 28, 31, 46 and 48 have been amended. Support for the amendment to claim 28 and 31 can be found throughout the specification (see, for example, the first and last paragraph of page 5). No new matter has been introduced by the instant amendments.

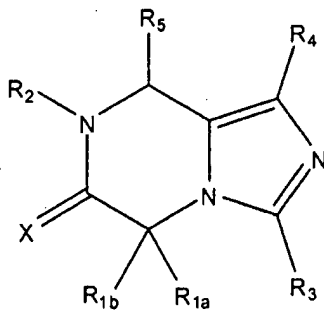
Applicants appreciate the Office's recitation of the preferred layout for a specification. As noted on page 3 of the specification, 37 CFR 1.77(b) provides a preferred format which is not a requirement for consideration of the patent application. As such, Applicants prefer to maintain the current formatting of the specification.

Claim 28 was objected for containing non-elected subject matter.

Claim 28 as presently amended is directed to subject matter of elected Group II as that group was defined in the Restriction mailed on December 27, 2007.

Claims 28, 31-38 and 46-49 stand rejected under 35 U.S.C. §112, first paragraph allegedly because the specification, while being enabling for a compound, composition, pharmaceutically acceptable salt thereof, where R_3 , R_4 , and R_5 are hydrogen; m and n are 0; X is O or H_2 ; R_{1a} is a substituted phenyl ring and R_{1b} is hydrogen, alkyl or benzyl, does not reasonably provide enablement for other compounds.

Although Applicant respectfully disagrees with the position taken by the Office, the scope of claim 28 has been amended. As an initial matter the structure of claim 28 has been amended to reflect Applicants election of Group II which obviates the need for variable Y . Thus, the original structure has been replaced with the formula:



In addition, compounds of claim 28 include those in which R_{1a} is optionally substituted monocyclic or bicyclic aryl or optionally substituted monocyclic or bicyclic heteroaryl;

R_{1b} is hydrogen, optionally substituted alkyl, or aralkyl;
R₂ is unchanged;
R₃, R₄ and R₅ are hydrogen; or
R₄-C may be replaced by nitrogen.

Applicants respectfully submit that substitution of naphthyl or heteroaryl for phenyl at the R_{1a} position is reasonably enabled by the numerous compounds exemplified in the specification containing an aromatic residue at the R_{1a} position. The R_{1a} residue is incorporated early into the synthetic procedure (see, Example 1 Step C) such that preliminary medicinal chemistry efforts would understandably focus on a handful of R_{1a} moieties in order to simplify the synthetic burden in exploring the structure-activity relationship. One of ordinary skill in the art would recognize based on the extensive number of exemplified compounds and the teachings in the specification at pages 1-10, that the Inventors had possession and taught how to make and use the compounds of claim 28 as presently amended.

Claims 31-38, as presented in the amendment filed February 26, 2008, appear to conform to the limited subject matter which the Office has acknowledged possessed enablement, e.g., compounds where R₃, R₄, and R₅ are hydrogen, m and n are zero, X is O or two hydrogen atoms, R_{1a} is substituted phenyl and R_{1b} is hydrogen, alkyl, or benzyl. As such, applicants request withdrawal of this rejection independent of the status of Claim 28.

Claims 46-49 were also rejected in the pending Office Action. However, the grounds on which these claims stand rejected has not been set forth in the Office Action. Applicants request clarification prior to rebutting the allegation of non-enablement.

Claims Applicants request withdrawal of the rejection and reconsideration of the claims.

Claims 28, 31-37 and 46-49 stand rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 46 and 48 have been amended as suggested by the Examiner. Thus, the rejection should now be moot.

Claim 28 stands rejected apparently due to (1) the use of terms such as "aryl," "heteroaryl" and the like and (2) the use of the term "substituted." Applicants traverse.

As noted by the Office Action, the specification provides ample definition of each of the terms in question. The specification defines the terms "aryl," "heteroaryl," "heterocyclyl," and "heteroaralkyl." The specification further defines substituents which may be appended to said terms. For example, "optionally substituted alkyl" is defined at page 2; "aryl" and substituents which may be present on the aryl ring are defined in the first paragraph on page 5, and "heteroaryl," "heterocyclyl," and "heteroaralkyl" and substituents which may be present thereon are defined on pages 5-7.

"It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language." MPEP2111.01 citing *in re Vogel* 422 F.2d 438, 441. The present definitions of "aryl" and "heteroaryl" are fully consistent with their ordinary and plain meaning in the field of chemistry and particularly in the field of medicinal chemistry. Moreover, the specification clearly and unambiguously provides specific definitions for the chemical residues which are consistent with the plain and ordinary meaning.

Paragraph 12 of the Action objects to the use of the term "substitution" in the claims. More particularly, the Office Action alleges that the use of the term "substituted" renders the claims indefinite.

Applicants respectfully disagree. The substituents which may be present for each group (e.g., alkyl, cycloalkyl, aryl, heteroaryl, heterocyclyl, etc) are defined in pages 2-7 of the specification. Applicants respectfully submit that the recitation of the optional substituents satisfies §112, second paragraph and MPEP 2111.01.

Claims 28, 31-37 and 46-49 are fully compliant with the requirements of 35 USC §112 including the definiteness requirements of §112, second paragraph. Applicants request withdrawal of the rejection and reconsideration of the claims.

Claim 28 stands rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Oida, et al. (JP 07101959).

The compound of Oida is unsubstituted at the positions corresponding to R_{1a} and R_{1b} of the structure of formula of claim 28.


In contrast, claim 28 as presently amended provides compounds in which R_{1a} is optionally substituted monocyclic or bicyclic aryl or optionally substituted monocyclic or bicyclic heteroaryl.

Thus claim 28 does not read on Oida. Claim 28 is therefore patentable over Oida.

This communication is believed to be fully responsive to the Office Action. Action on the merits is respectfully requested.

Respectfully submitted,

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